

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MARK S. CHANG, HAO FANG
and
KING WAI KELWIN KO

Application 09/539,458

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on March 20, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on April 8, 2005.

37 CFR § 41.37(c)(1)(v) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

The Appeal Brief is missing the “Evidence appendix” and the “Related proceedings appendix.” Correction is required.

In addition, an Information Disclosure Statement (IDS) was filed on January 15, 2002. It is not apparent from the record whether the examiner considered the statement submitted or notified appellants regarding why their submission did not meet the criteria set forth in 37 CFR §§ 1.197 and

1.98. A communication notifying appellants of the Primary Examiner's decision is required.

Finally, a Reply Brief was filed on July 19, 2005. There is no evidence in the IFW file to suggest that the examiner considered the Reply Brief.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellants to submit a paper providing the "Evidence appendix" and "Related proceedings appendix";
- 2) for consideration of said paper;
- 3) for consideration of the IDS filed January 15, 2002, and written notification to appellants regarding the Primary Examiner's decision;
- 4) for appropriate notification to appellants regarding consideration of the Reply Brief filed July 19, 2005; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: Patrick J. Nolan
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571) 272-9797

PJN:psb

Kelly K. Kordzik
Winstead Sechrest & Minick
P.O. Box 50784
Dallas, TX 75201